

REMARKS

Applicant acknowledge receipt of an Office Action dated June 10, 2008. Claims 1-7 and 9-20 remain pending in the application.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Statement of Substance of Interview

During an interview conducted on September 26, 2008, Examiner L. Soroush and Mr. Paul D. Strain discussed the rejections set forth in the outstanding Office Action, and, in particular, the differences between “silicone oil” and “silicone resin” as well as the differences between “siloxane” and “siloxysilicate”. Examiner Soroush and Mr. Strain also discussed the declaration and comparative data of record in this application.

Rejection Under 35 U.S.C. § 103

On page 2 of the Office Action, the PTO has rejected claims 1, 3-7, 9-10, 12, 14-16 and 18-20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 02/03928 to Ichinohe *et al.* (hereafter “Ichinohe”) (translation: US Publication no. 20030082218A1 – previously presented) in view of U.S. Patent 4,892,726 to Yonekura, *et al.* (hereafter “Yonekura”) previously presented, EP 0523 911 A2 to Roidl - previously presented and US Patent No. 6,534,044 to Wade *et al.* – previously presented. Applicants traverse this rejection for the reasons set forth below.

Also on page 8 of the Office Action, the PTO has rejected claims 2 and 17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 02/03928 to Ichinohe *et al.* (hereafter “Ichinohe”) (translation: US Publication no. 20030082218A1 – previously presented), U.S. Patent 4,892,726 to Yonekura, *et al.* (hereafter “Yonekura”) previously presented, US Patent No. 6,534,044 to Wade *et al.* – previously presented and EP 0523 911 A2 to Roidl - previously presented as applied to claims 1, 3-7, 9-10, 12, 14-15 16 and 18-20 as above and further in view of Fukuchi (English translation, JP 01211518 A). Applicant traverse this rejection for the reasons set forth below.

And finally on page 10 of the Office Action, the PTO has rejected claims 11 and 13 under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 02/03928 to Ichinohe *et*

al. (hereafter “Ichinohe”) (translation: US Publication no. 20030082218A1 – previously presented), U.S. Patent 4,892,726 to Yonekura, *et al.* (hereafter “Yonekura”) previously presented, US Patent No. 6,534,044 to Wade *et al.* – previously presented and EP 0523 911 A2 to Roidl - previously presented) as applied to claims 1, 3-7, 9-10, 12, 14-15, 16 and 18-20 as above and further in view of Hayashi *et al.* (English translation, JP 2000327948A).

Applicant traverse these rejections for the reasons set forth in their previously filed responses and for the additional reasons set forth below.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants’ disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Here, none of the cited references, whether taken individually or in proper combination, teach or properly suggest a “perfluoroalkyl group-containing polyalkylsiloxysilicate” as recited in the present claims.

Silicone Oil/Silicone Resin

Silicone oil and silicone resin are different in structure and property as follows (please refer to Annex 1).

Silicone oil has a linear structure (as shown below and in Annex 1) and is a fluid with flowability.



Fig. 1 - Silicone Oil

Meanwhile, silicone resin has a network structure and is a solid generally in powder form. Silicone resin powder is often used with a solvent which dissolves or disperses the powder in a cosmetic preparation.

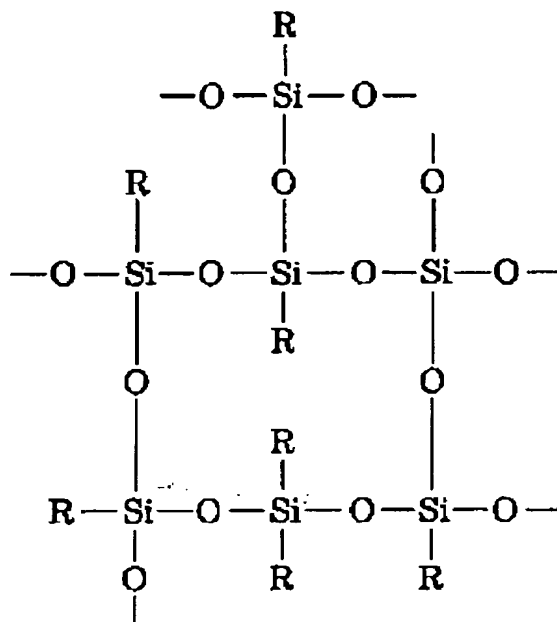


Fig. 2 - Silicone Resin

Applicants respectfully request that the PTO reconsider the outstanding rejections in view of these comments regarding the differences between silicone oil and silicone resin.

Siloxane/Siloxysilicate

In addition to the foregoing, Applicants also wish to note that siloxane and siloxysilicate are different in structure as we explained in the response filed on February 28, 2008. In this regard, Applicants wish to direct the PTO's attention to Annex 2.

Siloxane has D-units and terminal M-units, having a linear structure as can be seen, for example, from the definition of dimethicone below:

DIMETHICONE

CAS Number: 9006-65-9; 9016-00-6;
63148-62-9

Empirical Formula:



Definition: Dimethicone is a mixture of fully methylated linear siloxane polymers end blocked with trimethylsiloxy units. It conforms generally to the formula:

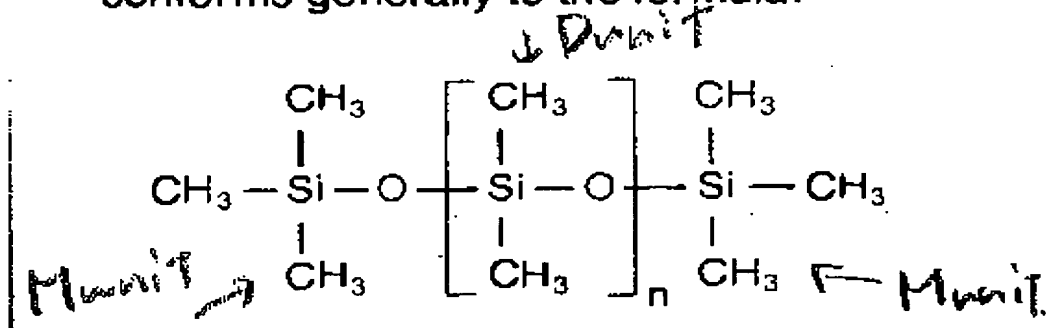


Figure 3 – Siloxane – Linear Structure – D-units and Terminal M-units

Meanwhile, Dimethicone has Q-units and terminal M-units, having a network structure.

TRIMETHYLSILOXYSILICATE

Definition: Trimethylsiloxysilicate is the silicone polymer that conforms generally to the formula: M unit Q unit

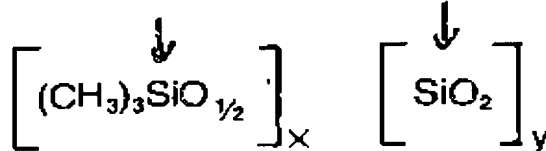


Figure 4 – Siloxysilicate – Network Structure – Q-units and Terminal M-units

While Annex 2 shows the general structural difference between siloxane and siloxysilicate, Applicants wish to acknowledge that the compounds (TRIMETHYLSILOXYSILICATE and DIMETHICONE) in Annex 2 are not fluorinated and

thus do not correspond exactly to Ichinohe, Roidl and the presently claimed invention. Applicants believe, however, that these definitions demonstrate the fundamental differences between siloxanes and siloxysilicates and request that the PTO reconsider the outstanding rejections in view of these differences.

Additional Remarks Regarding Ichinohe, Roidl, and the Presently Claimed Invention

The perfluoroalkyl group-containing polyalkylsiloxysilicate of the presently claimed invention is a silicone resin having a network structure. In this regard, Applicants wish to refer to Annex 3, and, in particular, the Figure reproduced below:

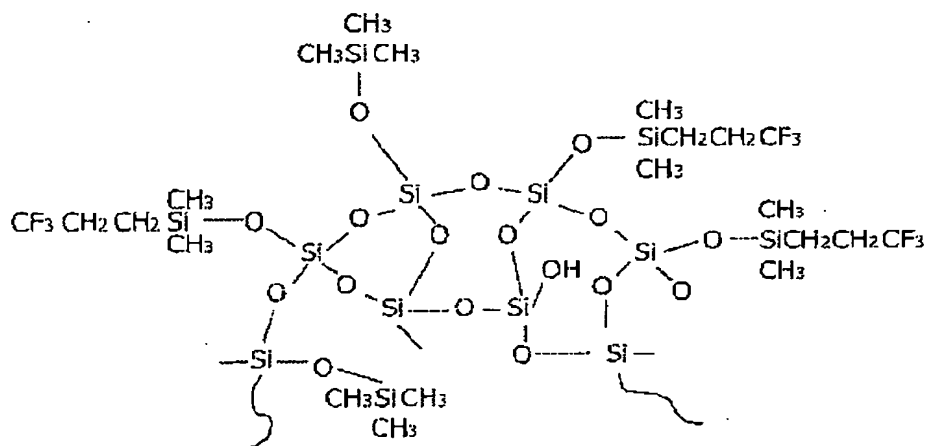


Figure 5 - Perfluoroalkyl Group-Containing Polyalkylsiloxysilicate – Network Structure

Meanwhile, the fluorine modified silicones recited in Ichinohe are silicone oil having a linear structure. For example, KF6017 used in Example 11 of Ichinohe has the structure shown in Annex 4 and reproduced below.

Polymethyl-3,3,3-trifluoropropylsiloxane in Roidl is referred to as fluid therein. Accordingly, it is silicone oil having a linear structure. The Examiner stated that “Polymethyl-3,3,3-trifluoropropylsiloxane is a perfluoroalkyl group-containing polyalkylsiloxysilicate” on page 12, lines 6 to 7 in the Official Action. That is not true. Polymethyl-3,3,3-trifluoropropylsiloxane is not a perfluoroalkyl group-containing polyalkylsiloxysilicate.

Ichinohe and Roidl are silent about the silicone resin of the present invention, *i.e.*, perfluoroalkyl group-containing polyalkylsiloxysilicate. Perfluoroalkyl group-containing

polyalkylsiloxysilicate makes it possible to impart a superior film forming ability to a cosmetic composition and also to provide a cosmetic composition with superior durability.

Comparative Data

On page 13 of the Office Action, the PTO has stated that “[f]urthermore, unless comparison is made with disclosure identical (not similar) with that of the reference, affidavits or declarations comparing applicant’s results with those of the prior art have no probative value.” (Emphasis added). Applicants respectfully submit that all comparative data, including comparative data present in a specification, is probative with respect to an obviousness determination.

In the present case, Applicants would like to point out that Comparative Examples 2 to 5 are not newly presented data. They were already disclosed in the present specification. Meanwhile, Example A and Comparative Examples A to C were presented in the declaration for the first time.

As discussed in Applicants’ previous response, no pigment was used in Example 11 of Ichinohe. However, it is clear from the comparison between Example 1 and Comparative Example C that perfluoroalkyl group-containing polyalkylsiloxysilicate is superior to trimethylsiloxysilicate in imparting cosmetic composition water-runability without temperature dependency.

Applicants respectfully request that the PTO reconsider its position with respect to the patentability of the present claims in light of these additional comments.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 103.

CONCLUSION


Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 10/10/08
FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5540
Facsimile: (202) 672-5399

By 
Paul D. Strain
Registration No. 47,369
Attorney for Applicant